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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,714	05/29/2001	Ching-Feng Wang	BHT-3111-169	5941

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DOUGHERTY & TROXELL  
SUITE 1404  
5205 LEESBURG PIKE  
FALLS CHURCH, VA 22041

EXAMINER

PICH, PONNOREAY

ART UNIT PAPER NUMBER

2135

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/865,714	WANG, CHING-FENG	
	Examiner	Art Unit	
	Ponnoreay Pich	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 12 and 13 are pending. The examiner notes that applicant is addressing arguments to former examiner Akpati. Applicant should be aware that this application had been docketed to a different examiner and any correspondence should be directed to the current examiner. Contact information may be found at the end of this office action. Applicant's arguments and amendments have been considered, but are moot in view of new grounds of rejections presented below.

#### ***Drawings***

The drawings submitted by applicant on 5/21/2001 are objected to for the following reasons:

1. There are several items in the figures which are incorrectly labeled as a result of improper translation. For example, the figures refer to a "servo", which the examiner believes should be "server". The figures refer to a "series number", which the examiner believes should be "serial number". See for example, Fig 3-5.
2. In Fig 2, item 22 states that "The network is encrypted further". It is unclear how a network can be further encrypted. Further, applicant's specification states on page 4 that item 22 should instead represent that data is further encrypted, not a network, see first paragraph on page 4, i.e. paragraph 17.
3. The flow chart shown in Fig 3 contain several translation errors that needs to be corrected. For instance, in item 120, it is unclear how the decrypt is transferred to the access device. The examiner assumes this to be an incorrect translation.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The abstract of the disclosure is objected to because there appears to be several translation errors that needs to be corrected. For example, the specification refers to a "series number", which the examiner assumes should instead be "serial number". In addition, applicant may wish to double check the wording of the abstract as some sentences does not appear to flow properly to the examiner, which may be the result of

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a literal translation from a foreign language. Correction is required. See MPEP § 608.01(b).

The lengthy specification contains several translation errors which makes the understanding of applicant's invention difficult. There are words and phrases which the examiner believes to be incorrect translations from another language, i.e. "servo" and "series number". In addition, there are several sentences in the specification which does not make any sense at all. Applicant should go through the entire specification to correct all errors which are the result of a bad translation. For the examiner to point out every error in the specification in a manner which still properly discloses applicant's invention would be impossible. Applicant may wish to take the opportunity in making these corrections to also add a CROSS REFERENCE TO RELATED APPLICATION section and make reference to the Taiwan application from which this application claims priority since the examiner does not see an application data sheet filed for this application and such information is usually located in either the CROSS REFERENCE section or an application data sheet. Applicant should also be aware that the manner in which the specification currently describes downloading data as seen in figures 4-5, it appears that a user directly interfaces with a network device over the network and directly receives encrypted data, which the user then downloads to an access device. Such a thing is impossible since with the current level of technology; humans still need a computing device to communicate over a network and cannot directly interface with networking devices over a network. The examiner assumes that this is also the result of translation error.

Also, considering the extent of corrections that the examiner believes applicant will have to make to the specification, the examiner respectfully asks that applicant supply to the examiner a complete copy of the corrected specification with corrections rather than just several substitute sheets as this would make it easier to determine if enough of the specification has been corrected that one of ordinary skill would be able to understand and make use of applicant's invention.

### ***Claim Objections***

Claims 12-13 objected to because of the following informalities:

1. Claims 12 and 13 refer to a "series number" which the examiner assumes should be "serial number".
2. After step e of each claim, in the wherein clause, the examiner believes "downloading" should just be "download" and "uploading" should just be "upload".
3. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 12 and 13 recite several limitations that are similar which were not described in the specification in such a way that would enable one of ordinary skill to make and/or use the invention. For instance, as per step d of each claim, the specification does not disclose how the encrypted data would be downloaded to the access device having the serial number. In fact, note Fig 4 and 5 and pages 4-5 of applicant's specification which discusses the figures. The specification and the figures disclose that the user is connected to the server, data from the server is transferred to the user, and the user downloads the data to the device, i.e. items 56 in Fig 4 and item 66 in Fig 5. It is unclear how a user can interface with a server, an electronic computing device, without the aid of any other computing device. Further, it is unclear how a user would then receive data and transfer data to the devices shown in Fig 4 and 5 also without the aid of any sort of device. Applicant's specification also does not disclose any means or method to practice step e of each claim, i.e. preventing users not connect to the access device having the serial number from receiving the encrypted data.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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1. As per claim 12, the final two line states that in the connecting step a), the access device is an MP3 player playing the music data. It is unclear how the access device can play the music data in step a) since the device does not obtain the music data until step d), where it is downloaded to the device.
2. Similarly, it is unclear in claim 13, how the access device can play the contents of the electronic book in step a) if it does not obtain the book data until it is downloaded onto the device until step d).
3. As per claims 12 and 13, it is unclear what is a "network connecting device". The examiner suspects this phrase to be a translation error and suspects applicant meant something more along the lines of a device which connects to a network.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Howard et al (US 2002/0069365).

**Claim 13:**



Howard discloses:

- a) Connecting an access device to a subscriber's end of a network (Fig 1 and p3, paragraph 31).
- b) Providing a serial number in the access device to the network and using the serial number as an encryption key (p6, paragraph 61 and p7, paragraph 74).
- c) Encrypting the data on the network to create encrypted data (p6-7, paragraph 69 and p7, paragraph 74).
- d) Downloading the encrypted data only to the access device having the serial number (p7, paragraph 74).
- e) Preventing users not connected to the access device having the serial number from receiving the encrypted data (p4, paragraph 42 and p7, paragraph 74).

Howard discloses wherein the access device is a network connecting device for data transmission used in the network (Fig 1 and p1, paragraph 14), the access device serving to selectively download data from and upload data to the network (p4, paragraph 42 and p7, paragraph 74), wherein in the encrypting step c) the data is an electronic book and in the connecting step a) the access device is an electronic book player playing the contents of the electronic book (p1-2, paragraph 15 and p5, paragraph 49).

Note that the examiner has interpreted the access device/electronic book player as the combination of a client computer and the limited-use web browser running on the client computer. One of ordinary skill should appreciate that the limited-use web

browser disclosed by Howard is merely software and it would need hardware, i.e. a computer, such as items 121 and 125 seen in Fig 1, to enable functionality of the browser. One of ordinary skill should appreciate that because the computer running Howard's limited-use browser is capable of displaying text and providing audio output, it inherently can either display the text of a book or play the audio recording of someone reading a book.

***Claim Rejections - 35 USC § 103***

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al (US 2002/0069365) in view of Candelore (US 6,697,489).

**Claim 12:**

Howard discloses:

- a) Connecting an access device to a subscriber's end of a network (Fig 1 and p3, paragraph 31).
- b) Providing a serial number in the access device to the network and using the serial number as an encryption key (p6, paragraph 61 and p7, paragraph 74).
- c) Encrypting the data on the network to create encrypted data (p6-7, paragraph 69 and p7, paragraph 74).
- d) Downloading the encrypted data only to the access device having the serial number (p7, paragraph 74).
- e) Preventing users not connected to the access device having the serial number from receiving the encrypted data (p4, paragraph 42 and p7, paragraph 74).

Howard discloses wherein the access device is a network connecting device for data transmission used in the network (Fig 1 and p1, paragraph 14), the access device serving to selectively download data from and upload data to the network (p4, paragraph 42 and p7, paragraph 74), wherein in the encrypting step c) the data is audio data and in the connecting step a) the access device is an audio player playing the audio data (p1-2, paragraph 15 and p4, paragraph 40).

Howard does not disclose the audio data being music data and the audio player being an MP3 player. However, it should be appreciated by one of ordinary skill that any device capable of playing audio data is capable of playing music since music is a type of audio. Further, Candelore discloses MP3-formatted audio files and MP3 recorders being well known in the art at the time applicant's invention was made (col 1, lines 23-44). It should be appreciated that if there are MP3 recorders that there would be devices which could play MP3 files.

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Howard's invention in light of Candelore's teachings according to the limitations recited in claim 12 such that the audio player was an MP3 player which plays MP3 formatted music data files. One of ordinary skill would have been motivated to do so because MP3 was a popular audio format at the time applicant's invention was made since it offered near CD quality music with relatively small file sizes. One of ordinary skill would also be motivated to do so because many web browsers at the time applicant's invention was made supported MP3 file formats.

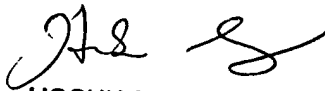
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ponnoreay Pich  
Examiner  
Art Unit 2135

  
HOSUK SONG  
PRIMARY EXAMINER

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